Docket No.: FLG-005
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Afeyan

Application No.: 09/914,110

Filing Date: February 5, 2002

For: METHOD AND SYSTEM CONSTITUTING A VIRTUAL COLLECTIVE ENTITY FOR MARKET-EFFICIENT RETAIL PURCHASE OF GOODS AND SERVICES

Confirmation No.: 9343

Art Unit: 3693

Examiner: Weisberger, Richard C.

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is responsive to the final Office Action mailed from the Office on April 17, 2008, for the above-identified patent application. Applicant encloses a Notice of Appeal under 37 C.F.R. § 41.31 and a Petition for Extension of Time under 37 C.F.R. § 1.136(a) extending the deadline for response by three months up to and including October 17, 2008. In addition, Applicant has authorized the Office to charge the associated fees to Deposit Account No. 07-1700.

Applicant believes that no other fees are due for the foregoing papers to be entered and considered. However, please consider this a conditional authorization to charge any additional fees necessary for entry of this paper to Deposit Account No. 07-1700.

Remarks begin on page 2 of this paper.

Remarks

Claims 1-13 and 15-29 are pending and presented for consideration.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 5-9, 10, 17, 19, 20, 23, 26 and 28 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,146,330 by Alon et al. ("Alon").

Alon is not prior art to the present application. A patent that is not entitled to the benefit of an earlier-filed application is available as prior art under 35 U.S.C. § 102(e) only as of the patent's actual filing date. Alon's priority document does not disclose Alon's claimed invention. Consequently, Alon is not entitled to the benefit of Alon's priority document and is available as a reference only as of its actual filing date, which is nearly one year *after* the priority date of the present application. Because Alon is not prior art to the present application, Applicant respectfully requests that the rejection be withdrawn and that the application proceed to allowance at this time.

If a patent is not entitled to the benefit of an earlier-filed application, the patent is available as prior art under 35 U.S.C. § 102(e) only as of its actual filing date, *regardless* of what disclosures may or may not be in the earlier-filed application. The court made this very clear in *In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981) (emphasis added): "If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support *for the invention claimed in the reference patent*." The court in *Wertheim* reversed the rejections of the claims:

> The board erred in ruling that since "the substance of the relevant disclosure in [the earlier-filed application] was carried over into the patent," that same disclosure in the reference patent was entitled to the [earlier] filing date .... While some of the reference patent disclosure can be traced to [the earlier-filed application], such portions of the original disclosure cannot be "carried over" for the purpose of awarding filing dates, unless that disclosure constituted a full, clear, concise and exact description in accordance with § 112, first paragraph, of the invention claimed in the reference patent. *Id.* at 538-539.

The Board of Patent Appeals and Interferences applies *Wertheim* in reversing rejections based on 35 U.S.C. § 102(e), where the earlier-filed application does not support the later-patented claims. *See, e.g., Ex parte Gardner* et al., Appeal No. 2003-2079, Application No. 09/207,972, 2003 WL 25284439 (Bd. Pat. App. & Interf.) (unpublished):

> The examiner states that whether the parent patent to Kizilyalli supports the limitations of Kiziyalli '238 is "irrelevant" to the present claims .... As correctly stated by Applicants ..., this is clear error since, to be entitled to the filing date of the Kizilyalli '435 application, the claims of Kizilyalli '238 must be disclosed pursuant to 35 U.S.C. §§ 120/112 in this parent application. See In re Wertheim ... (Patent Office that wishes to utilize against applicant part of patent disclosure found in application filed earlier than date of application that became patent must demonstrate that earlier-filed application contains Sections 120/112 support for invention claimed in reference patent).

See also Ex parte Motoyama, Appeal No. 2002-0867, Application No. 08/738,659, 2003 WL 23280006 (Bd. Pat. App. & Interf.) (unpublished): "If ... [the USPTO] wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent. Wertheim, 646 F.2d at 537 ...."

Alon's priority document cannot *support* Alon's claimed invention, because it does not *describe* Alon's claimed invention.

Alon's priority document does not provide a "full, clear, concise and exact description in accordance with § 112, first paragraph," of the invention claimed in Alon. Indeed, Alon's priority document does not describe the subject matter of any of Alon's 62 claims. Applicant refers the reader to pages 8 and 9 of Applicant's paper of January 10, 2008 for a detailed explanation of the deficiencies of Alon's priority document, and will here merely reiterate that Alon's priority document does not recite or teach the concept of an "agent entity," a key limitation of Alon's independent claims 1, 12, 18, 31, 47 and 62, or of "verification" as recited in Alon's independent claims 22 and 61. Alon's priority document therefore does not describe Alon's claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112. Regarding these key limitations, the Office action of April 17, 2008 merely states that "the examiner finds the original disclosure enabling" for the feature or, "[i]n the alternative, [that] it would have been obvious." Respectfully, Alon is not entitled to the benefit of Alon's priority

document unless Alon's priority document provides a "full, clear, concise and exact description in accordance with § 112, first paragraph," of Alon's claimed invention, *regardless* of what Alon's priority document may or may not enable or render obvious. That Alon's priority document fails to describe Alon's claimed invention is uncontested in the record. Because Alon's priority document does not describe Alon's claimed invention, Alon's priority document does not support Alon's claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112.[1]

Because Alon is not entitled to the benefit of Alon's priority document, Alon is available as a reference under 35 U.S.C. § 102(e) only as of its actual filing date of February 3, 2000, *nearly one year after Applicant's priority date*.

Because none of Alon's independent claims 1, 12, 18, 22, 31, 47, 61 and 62 are supported by Alon's priority document, Alon's priority date is the actual filing date of Alon's nonprovisional application, February 3, 2000.

Applicant also respectfully submits that Applicant's claims, in sharp contrast to the Alon claims, are properly supported by Applicant's parent application in compliance with 35 U.S.C. § 112, first paragraph, and that the present application is entitled to the benefit of the filing date of Applicant's parent application, filed February 22, 1999. The entitlement of the present application to the benefit of the filing date of Applicant's parent application is uncontested in the record. Accordingly, the critical 102(e) reference date of Alon post-dates the effective filing date of the present application and does not qualify as prior art under 35 U.S.C. § 102 or, by extension, under 35 U.S.C. § 103. Applicant therefore respectfully requests that these rejections be reconsidered and withdrawn.

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[1] A relevant comparison can be drawn to the Federal Circuit decision in *New Railhead Mfg. L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (2002) as discussed in the *Manual of Patent Examining Procedure, Eighth Edition 201.11(I)(A)*: "The court looked at claim 1 of the '283 patent which recites a bit body being angled with respect to the sonde housing. The court then reviewed the provisional application and concluded that nowhere in the provisional application is the bit body expressly described as 'being angled with respect to the sonde housing' as recited in claim 1 of the '283 patent. The court held that the disclosure of the provisional application does not adequately support the invention claimed in the '283 patent as to the angle limitation and therefore, the '283 patent is not entitled to the filing date of the provisional application under 35 U.S.C. 119(e)(1) …."

Conclusion

Applicant respectfully requests that the rejections be withdrawn and that the application proceed to allowance at this time. The Office is invited to contact the undersigned with any questions about this submission.

Respectfully submitted,

Date: October 15, 2008
Reg. No. 48,645

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Similarly, here, Alon's priority document does not expressly describe agent entities or verification as claimed in Alon; does not adequately support the invention claimed in Alon, and does not entitle Alon to the benefit of Alon's priority document.